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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,423	10/12/2001	Kirk Hogan	HOGAN-06650	2436
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MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			EXAMINER GOLDBERG, JEANINE ANNE	
			ART UNIT 1634	PAPER NUMBER

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,423

Applicant(s)

HOGAN, KIRK

Examiner

Jeanine A. Goldberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Board Decision Mailed July 25, 2006.
2. Currently, claims 72-107 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 72-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acta Anaesthesiologica Scandinavica (Vol 39, page 139-141, 1995) and La Du (Cellular and Molecular Neurobiology, Vol 11, No. 1, page 79-89, 1991) and Pharmacogenetics (Chapter 4, pages 309-326) and Evans et al (Science, Vol. 286, pages 487-491, October 1999) in view of Hoon et al. (US Pat. 6,057,105, May 2, 2000) and Hacia (Nature Genetics Supplement. Vol. 21, pages 42-47, January 1999) and further in view Ahern (The Scientist, Vol 9, No. 15, page 20, July 1995).

It is noted that these claims contain a preamble which recites an intended use, however, it is also noted that this use does not confer patentable weight on the product claims since the preamble does not materially change what is present in the kit itself and thus represents an intended use of the kit (see MPEP 2111.02). Further, with regard to the limitation that the kits contain instructions for using said kit for generating said perioperative genomic profile for said subject, the inclusion of instructions is not

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considered to provide a patentable limitation on the claims. See In re Ngai, 367 F.3d 1336, 70 U.S.P.Q.2d 1862 (Fed. Cir. 2004) (holding that an inventor could not patent known kits by simply attaching new set of instructions to that product).

Acta Anaesthesiologica Scandinavin (referred to as AAS) teaches that certain variants have a dramatic degree of resistance to the drug, succinylcholine (SC), because they destroy it so rapidly. AAS teaches that individuals show no regular metabolic disorder unless SC or mivacurium is given such that the condition is provoked. BchE mutations are dibucaine resistant, fluoride resistant or silent. SC and mivacurium are potentially toxic in people with BchE deficiency. AAS teaches that the principles of molecular biology tests and their application to BchE variants are well illustrates and anesthesiologists need to keep up to date about these applications. AAS also teaches that other hereditary conditions of special interest to anesthesiologists, such as malignant hyperthermia, may be diagnosed by similar methods in a few years (page 141).

La Du et al (herein referred to as La Du) teaches butyrylcholinesterase variants which have been found in individuals who have responded abnormally to the muscle relaxant succinylcholine. Variants with increased activity are resistant to succinylcholine and may require two or three doses to achieve the desired state of paralysis (page 80). La Du teaches specific variants in the Butyrylcholinesterase gene.

Pharmacogenetics teaches polymorphisms of desbrisoquine hydroxylase (Cytochrome P4502D6). The structures of CYP2D gene clusters are provided. The poor metabolizers are depicted. Pharmacogenetics teaches that for drugs such as

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codeine and encainide it is the PM subjects who may experience therapeutic failure (page 317, col. 1). Codeine is ineffective analgesic in the 5-10% of the population who have a PM phenotype. The discovery and identification of each of these conditions has saved some lives and may prevent future fatalities or morbidities.

Evans et al (herein referred to as Evans) teaches that the drug-metabolizing enzyme debrisoquine hydroxylase (CYP2D6) is polymorphic. Evans teaches that "inherited differences in drug-metabolizing capacity are generally monogenic traits and their influence on the pharmacokinetics and pharmacologic effects of medications is determined by their importance for the activation or inactivation of drug substrates (page 487, col. 2). Evans also teaches "the effects can be profound toxicity for medications that have a narrow therapeutic index and are inactivated by a polymorphic enzyme (for example, mercaptopurine, azathioprine, thioguanine, and fluorouracil) or reduced efficacy of medications that require activation by an enzyme exhibiting genetic polymorphism (such as codeine)" (page 487, col. 3). Evans illustrates in Figure 2, drug-metabolizing enzymes known to exhibit genetic polymorphisms with incontrovertible clinical consequences. Further, severe and potentially fatal hematopoietic toxicity occurs when thiopurine methyltransferase-deficient patients are treated with standard doses of azathioprine or mercaptopurine. Evans teaches "many opioid analgesics are activated by CYP2D6 rendering the 2-10% of the population who are homozygous for nonfunctional CYP2D6 mutant alleles relatively resistant to opioid analgesic effects. Thus is it not surprising that there is remarkable interindividual variability in the adequacy of pain relief when uniform doses of codeine are widely prescribed" (page

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489, col. 1). Evans teaches that individualizing drug dosages can improve clinical outcome (page 491, col. 1). Evans specifically suggests making a DNA array for automated, high-throughput detection of functionally important mutation in genes that are important determinants of drug effects such as drug-metabolizing enzymes. The suggested genes on the array include TNF, MTHFR and CYP2D6, for example (see figure 3).

Thus, the prior art clearly illustrates that the claimed genes are known to be related to resistance to anesthesia.

Moreover, Hoon et al. (herein referred to as Hoon) teaches the benefits of using multiple markers in detection assays. Hoon teaches using multiple markers provides increased sensitivity (abstract). Hoon teaches that marker combinations may be developed, which are particularly sensitive to the effect of therapeutic regimens on disease progress such that patients may be monitored (col. 4, lines 65-68). In a particular example, Hoon demonstrates that number of markers was studied and that using four markers was significantly better than a single marker alone (col. 21).

Additionally, Hacia teaches mutational analysis using oligonucleotide microarrays. Hacia teaches that arrays of 1,480 oligonucleotide probes were designed to detect 37 known mutations, probes were spotted on surfaces to detect mutations in HBB, and BRCA1. Hacia teaches that arrays of 135,000 probes were used to interrogate the entire 16.6kb human mitochondrial genome from ten samples (page 44, col. 1). Chips have also been used for the simultaneous genotyping of 500 markers (page 45, col. 1). Hacia teaches that chips allow for unprecedented throughput in

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mutational analysis with a high degree of accuracy (page 46, col. 2). Hacia illustrates the design of probes and oligonucleotides for detection of single nucleotide substitutions and variations. As seen in Figure 3, for example, 25 overlapping 25-base probes are affected by changes in a single target nucleotide. Moreover, Hacia teaches that the analysis is completed by scanning for variation and evaluation using an algorithm (page 44)(i.e. a computer program directing the processor to analyze the data). As seen in Figure 5, the data is outputted from a computer program to illustrate the detection of polymorphisms.

Finally, Ahern teaches reagent kits offer scientists good return on investment. Ahern teaches kits save time and money because the kits already come prepared. Ahern teaches kits may comprise instructions that provide researcher detailed instructions to follow.

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have packaged the necessary reagents for sampling patients prior to subjecting the patient to anesthetics for the presence of alleles within the CYP2D6, or BCHE genes which cause resistance to the drug, succinylcholine (SC), resistant to succinylcholine, desbrisoquine hydroxylase, as taught by *Acta Anaesthesiologica Scandinavica*, La Du , *Pharmacogenetics*, or Evans and thus avoiding any fatal reaction to the anesthesia, for example.

As discussed above, AAS teaches that SC and mivacurium are potentially toxic in people with BchE deficiency. La Du et al teaches butyrylcholinesterase variants which have been found in individuals who have responded abnormally to the muscle

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relaxant succinylcholine and the variants with increased activity are resistant to succinylcholine and may require two or three doses to achieve the desired state of paralysis (page 80). Pharmacogenetics teaches that codeine is ineffective analgesic in the 5-10% of the population who have a PM phenotype. Evans also teaches “the effects can be profound toxicity for medications that have a narrow therapeutic index and are inactivated by a polymorphic enzyme (for example, mercaptopurine, azathioprine, thioguanine, and fluorouracil) or reduced efficacy of medications that require activation by an enzyme exhibiting genetic polymorphism (such as codeine)” (page 487, col. 3).

Moreover, given the teachings of Hoon and Hacia that sampling multiple markers provides increase sensitivity, the ordinary artisan would also be motivated to have sampled additional markers which are associated with complications in surgery. Therefore, the skilled artisan would have additionally analyzed a patient for a dramatic degree of resistance to the drug, succinylcholine (SC), resistant to succinylcholine, desbrisoquine hydroxylase, or venous thromboembolism, as taught by Acta Anaesthesiologica Scandinavica, La Du, Pharmacogenetics, or Evans. Given the state of the art with relation to known markers and detecting the markers as indicative of certain disease which either trigger episodes when exposed to anesthetics, or are poor metabolizers or potentially cause thrombosis are well known. The ordinary artisan would have been motivated to have packaged reagents needed to screen individuals to determine the genetic composition of the individuals to provide individualized diagnosis

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and to avoid any fatal reaction to the anesthesia in a quick and efficient cost effective kit.

Hacia teaches that large numbers of probes are placed on arrays for the express benefit of high-throughput mutational analysis with a high degree of accuracy (page 46, col. 2). The ordinary artisan would have recognized that the art provides a large number of single nucleotide polymorphisms or other variations which are indicative of conditions. The benefit of screening individuals for several of these prevalent mutations which are related to surgery would have allowed the anesthesiologist to determine whether plausible substitutes may be provided to patients which would not cause these conditions to arise. Specifically, codeine should be administered with care to individuals having certain BchE mutations. Combining more than one screening method to determine the genomic profile of a patient would have provided the anesthesiologist with a more complete picture of the patients genetic make-up. As suggested in many of the articles, individual treatment and screening is ideal for analysis of the genetic make-up of patients.

In summary, the prior art teaches

- * Numerous mutations in numerous genes which are associated with toxicity, decreased or increased efficiency, ineffective to various operative drugs (De Lu, AAS, Poort, Evans, for example)
- * Methods using multiple markers provide increased sensitivity over methods employing single markers (see Hoon)
- * Arrays for high-throughput and highly accurate mutational analysis which may be used for as many as 500 mutations (Hacia)
- * Packaging reagents into a kit saves time and money (Ahern)

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Thus, the ordinary artisan would have been motivated to have packaged the primers, probes, and reagents of Acta Anaesthesiologica Scandinavica, La Du, Pharmacogenetics, or Evans and Hacia and Hoon which are necessary for determining the genotypes of BchE and CYP2D6 which are associated poor reactions to anesthesia into a kit, as taught by Ahern for the express purpose of saving time and money.

As decided at the Federal Circuit in May 2004, In re Ngai succinctly states that inventors are not "entitled to patent a known product by simply attaching a set of instructions to that product." Whether the instructions are printed on a piece of paper within the kit or the instructions are printed in the memory of the computer for execution, the instructions remain just instructions. With regard to Claims 72-107, the intended use of the instructions written in the memory or program of the computer would not change the product. Therefore, the different instructions provided in Claims 72-107 do not distinguish over the prior art.

Conclusion

4. No claims allowable over the art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (571) 272-0743. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 4:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Central Fax Number for official correspondence is (571) 273-8300.


Jeanine Goldberg
Primary Examiner
August 29, 2006



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